REMARKS

Claims 1-3, 6 and 11-13 are pending.

Claims 1-3, 6 and 11-13 are rejected.

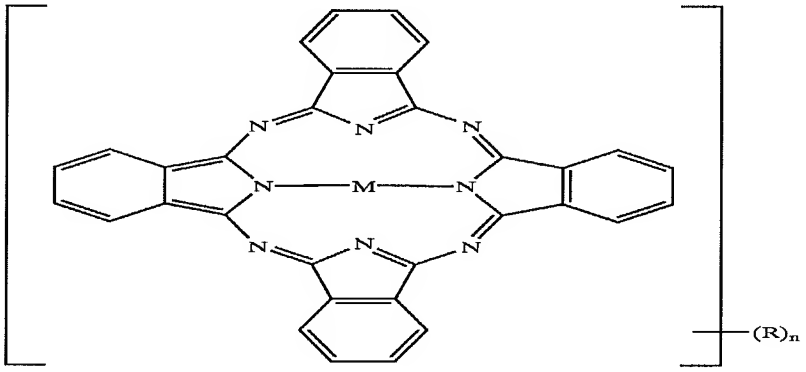
35 USC 103 (a)

Claims 1, 3, 6 and 12and 13 are rejected under 35 USC 103(a) as being unpatentable over Tronche, US 2002/0025402 in view of Kakuta, US 6,661,770.

Examiner believes Tronche to teach components b) through e). Applicants agree that Tronche does not teach the specific phthalocyanine of formula (1) presently claimed. However, according to the examiner, Kakuta teaches an optical recording layer comprising a copper phathalocyanaine dye wherein the substituent is preferably a hydroxyl group.

Applicants respectfully disagree. Kakuta teaches a phthalocyanine of general formula (I), col. 10, lines 5-20.

General Formula (I)



R is defined in col. 10, lines 27-53. Not one of the R substituents defined in lines 27-53 includes an hydroxyl group.

Examiner refers to col. 10, line 66 and makes the statement that Kakuta teaches a phthalocyanine dye wherein the substituent is preferably a hydroxyl group.

However, Kakuta does not teach direct OH substitution of the aromatic rings of the phthalocyanine but instead teaches in col. 10, lines 54-66 that

> in the general formula (I) the substituent represented by R **may further have a substituent, and examples of this substituent include the following. "**

Examples of this substituent include..... a hydroxyl group,...."

Thus R is NOT defined as hydroxyl but instead is a substituent of R. Accordingly, Kakuta does not teach the presently claimed phthalocyanine.

As an obviousness rejection requires the suggestion of all elements of the claim and the above rejection fails to do this, the rejection is overcome.

Claims 1, 6 and 13 are rejected under 35 USC 103(a) as being unpatentable over Sasaki, US 4,789,620 in view of Wolleb et al., US 6,444,807.

Examiner believes Sasaki to disclose photosensitive compositions similar to those presently claimed but does not teach the phthalocyanine green colorant which has the structure the formula of instant claim 1. However, examiner uses Wolleb to make up for this deficiency. Examiner refers to the phthalocyanine structure exemplified in example B10 in column 19 if Wolleb which according to the examiner meets the limitations of instant claim 1, when n=0 wherein the oxygen is directly attached to the benzene ring.

Applicants respectfully point out that there is no overlap between the above Wolleb structure and the presently claimed formula (1). The structure of Wolleb requires four specific sulfonamides as substituents on the phthalocyanine. The present claim limitations do not allow for such a sulfonamide. Thus there is no overlap.

Because Wolleb does not suggest the present phthalocyanine of formula (1), the above combination cannot make the claimed composition obvious. Therefore, the rejection is overcome.

Claims 1, 2, 6, 11 and 13 are rejected under 35 USC 103(a) as being unpatentable over Karasaw, US 6,051,360 in view of Yashiro, US 7,144,677.

The examiner believes Karasaw to teach a photoresist composition comprising a dye and components b) through e). Karasaw does not teach the specific phthalocyanine dye as in instant claim 2. However, examiner believes Yashiro to teach a recording layer comprising a copper phthalocyanine dye with substituents meeting the limitations of claim 2. Examiner opines further that the substituent

group (-O-C(R1) (R3)-R2 is preferred by Yashiro to attach to the phthalocyanine compound to improve recording sensitivity, adjust absorption wavelength of the recording layer and improve soluboility in the coating solvent 9co. 7, lines 11-14).

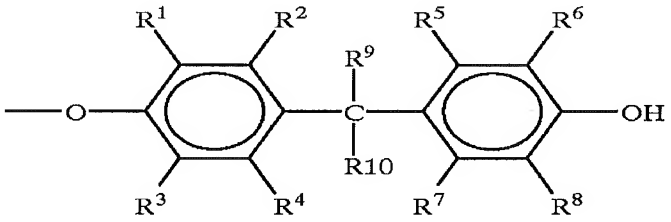
Applicants respectfully disagree with the examiner's analysis for the following reasons.

Firstly, Yashiro does not prefer the substituent group (-O-C(R1) (R3)-R2) but instead teaches that "other groups" may be added to the substituent groups A1-A8 to improve recording sensitivity, adjust the absorption wavelength etc. These suggested groups which may be used to alter the recording sensitivity, adjust absorption wavelength etc. are numerous and may be chosen from any of those recommended in col. 5, lines 51 through col. 7, line 42.

Secondly, the objective of Karasaw is to improve conventional filters and dyestuffs. Karasaw does this by introducing a specific substituent group, namely, a group represented by the formula (7)

Formula (7) being:

(7)



into the chromophoric nucleus. The introduction of the formula 7 onto the chromophoric nucleus provides the excellent solubility in solvents and binder resins of Karasawa and makes possible the color filters excellent in transmittance characteristics and durability. See co. 3, lines 40-45. Thus without the introduction of this formula 7, Karasawa's invention is inoperative. Thus even if one skilled in the art were given sufficient direction from Yashiro to arrive at the presently claimed phthalocyanine of formula 1 (applicants do not believe there to be sufficient direction from Yashiro), the combination would also require the introduction of the specific group of formula (7) to the phthalocyanine residue. This alteration (necessary from the teachings of Karasawa) would place the new phthalocyanine derivative outside the definition of the presently claimed formula (1). Thus the combination of the two references does not arrive at the present claim limitations and the obviousness rejection is overcome.

The applicants respectfully request reconsideration and withdrawal of the rejections to claims 1-3, 6 and 11-13 in light of the above remarks.

Since there are no other grounds of objection or rejection, passage of this application to issue with claims 1-3, 6 and 11-13 is earnestly solicited.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, applicants request that the examiner contact the undersigned representative.

Respectfully submitted,

Ciba Specialty Chemicals Corporation
540 White Plains Road
Tarrytown, New York 10591
(914) 785-2768
SAL\22798R3.doc

Shiela A. Loggins
Agent for Applicants
Reg. No. 56,221